Remarks

Applicant has amended claims 1, 7, 15, 21, 26-28, 30 and 32; and cancelled claims 9, 20 and 25. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application (see e.g., cancelled claims 20 and 25). Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has rejected claims 1-4, 6, 7, 9, 1[1], 12, 15-27, and 32 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,031,471 (Stefik et al.) in view of U.S. Application Serial No. 2003/2208494 (King et al.) and U.S. Patent No. 7,395,431 (Fukushima et al.)[2].

All of the pending claims are directed toward a system that prints a mark on each page of a *printed* document. The mark includes data unique to each page of the *printed* document. The mark on each page of the *printed* document is stored by page with essential data and is invisible so the mark will not copy and may be of a forensic ink. In other words, the document that is printed is provided with an overt mark that includes data unique to each page of the printed document, such that, in the event of unauthorized copying of the document, an authenticatable document cannot be reproduced. While a copy of the printed document could be made, this copy could not be authenti-

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[1] The Official Action dated May 25, 2010 at page 2 states that "Claims 1-4, 6, 7, 1, 12, 15-27, and 32 are rejected under 35 U.S.C. 103(a)", however, Applicant believes the "1" listed for a second time was intended to refer to claim 9 as on page 7 of the Official Action the examiner applies the teachings of cited references to "Claim 9."

[2] The Official Action dated May 25, 2010 at page 2 states that "Claims 1-4, 6, 7, 1, 12, 15-27, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 7,031,471) in view of King et al. (US 2003/2208494) and Ishida et al. (US 7,395,431)." However, U.S. Patent No. 7,395,431 is issued to Fukushima et al., not Ishida et al. Likewise, the previous rejection included the combination of Stefik et al., King et al. and U.S. Patent No. 7,259,878 (Ishida et al.), and the examiner stated at page 2 of the current Official Action that there are "new ground(s) of rejection." Additionally, the portions in the Official Action that are referred to as referencing Ishida et al., are in fact, referencing Fukushima et al. According, Applicant is treating the rejection as a combination of Stefik et al., King et al. and Fukushima et al.

cated because the mark placed on each page of the documents would not be copied (e.g. a photocopier will not see the mark and therefore will not copy it). As such, the system is directed toward a system that can create an authentic printed document, however, unauthorized copying of the authentic printed document will result in copy that cannot be authenticated because it will not have the mark positioned on each page of the originally printed authentic document. Applicant has amended the claims to clarify this point. For example, claim 1 recites in part "a mark printed by said printer on each page of the printed file, said mark containing data unique to each page of the printed file . . . wherein said mark printed on each page of the printed file comprises covert data" and "wherein reproduction of the printed file as an authenticable printed file is prevented by means of the mark containing data unique to each page of the printed file." The pending independent claims have been amended to substantially include similar limitations (See, claims 1, 15, 21, 26-28 and 32).

Applicant respectfully submits that Stefik et al. fails to teach "a mark printed by said printer on each page of the printed file, said mark containing data unique to each page of the printed file . . . wherein said mark printed on each page of the printed file comprises <u>covert</u> data." Rather, Stefik et al. teaches that a "system for controlling the distribution and use of digital works" by "use of dynamically generated watermark information that is embedded in the rendered output." (Abstract). The watermark will "aid in deterring or preventing unauthorized copying of the rendered work" as the system "provides for attaching persistent usage rights to digital work." (Id.) In other words, the mark is prominently displayed on the unauthorized copy and cannot be removed (i.e. is a "persistent" mark). This is the exact opposite of the presently pending claims that recite "covert data." The covert data cannot be copied on, for example, a copy machine, such that an authorized copy (e.g., a document including the covert data) cannot be made. In effect, the only way to make an authorized document is to print the document to include the covert mark.

It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that modification of Stefik et al. to provide covert data that cannot be copied works directly against the primary teachings of Stefik et al. to provide a mark that is "persistent" (i.e., a mark that cannot be removed). Such a modification cannot be obvious.

King et al. likewise fails to teach or disclose this limitation. King et al. is directed toward a system that places a bar code on a PDF image. (Para. 59). Nowhere does King et al. teach that the bar code is covert. Still further, Applicant respectfully submits that Fukushima et al. also fails to teach the limitation that a mark on a printed page is covert. In fact, Fukushima et al. appears to be entirely directed toward a system that encrypts digital information and will not display the copyrighted information without the proper authorization. For example, Fukushima et al. states,

> It is an object of the present invention to more strongly protect data to be distributed from being illegally plagiarized, and further, to add an electronic watermark function necessary to protect the copyright to all reproduction means apparatuses. In order to achieve the above-described objects, according to the present invention, data targeted for protection is encrypted, and an encryption key required for decrypting this encrypted data and reproduction control data for protecting the copyright are embedded in encrypted data through the use of the electronic watermark. Thus, when reproducing the data, the electronic watermark is detected, and the encryption key required for decrypting the cryptogram and the reproduction control data for protecting the copyright are restored. Through the use of the restored encryption key, the cryptogram is decrypted. Thus, through the use of the reproduction control data restored, the reproduction of the data targeted for protection is controlled.

(Abstract) (emphasis added). Accordingly, Fukushima et al. is directed toward a system that prevents an unauthorized user from accessing digital information without the proper decrypting information. This is very different from the present claims, which are directed

toward a system that prevents a unique mark on ***printed*** pages from being copied, but does not prevent the other information on the pages from being copied resulting in the generation of an unauthorized copy (i.e., a copy with no marking on the pages).

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not identified all the elements of the pending claims (the mark comprising covert data), nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. In fact, Stefik et al. teaches directly away from this limitation and therefore could not be properly modified to include this limitation. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984).

It is respectfully submitted that claims 1-19, 21-24, 26-28, 30 and 32, all of the claims remaining in the application, are in order for allowance and an early notice to that effect is respectfully requested.

Respectfully submitted,

/Wesley W. Whitmyer, Jr./

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